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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,228	09/12/2003	Paul Spaeth	16222U-012510US	6840
20350	7590	03/09/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/661,228	Applicant(s) SPAETH ET AL.	
	Examiner EDWYN LABAZE	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-15,17-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-15,17-22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 2/21/2006.
2. Claims 1-2, 4-8, 10-15, 17-22, and 24-30 (including new claims 28-30) are presented for examination.
3. This application claims benefit of 60/410,555 filed on 09/13/2002.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-2, 4-8, 10-15, 17-23, and 24-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Carpentier et al. (U.S. 6,976,165).

Re claims 1, 5-6, 7, 13, 20, and 25-26: Carpentier et al. {hereinafter referred as “Carpentier”} discloses system and method for secure storage, transfer and retrieval of content

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addressable information, which includes a token acceptance device configured {herein Carpentier described a smart card to be inserted in a smart card terminal, wherein the terminal could be mobile telephones, personal digital assistants} to receive the portable token (col.25, lines 15-25), the token having a current token image and an update indicator, wherein the portable token is configured to be used in a financial transaction {herein Carpentier described escrow management, insurance and health} (col.21, lines 1-47); and a server configured to communicate with the token via the token acceptance device (col.9, lines 60+; col.14, lines 8+; col.22, lines 10+); wherein upon receiving an indication {herein interpreted as Intrinsic Unique identifiers/TUI set by the issuer} that the token image on the portable token is to be updated (col.25, lines 4-25), the server retrieves a backup token image for the portable token and uploads the backup token image to the portable token via the token acceptance device to replace the current token image on the portable token the backup token image comprising updated financial or loyalty transaction information for the portable token (col.20, lines 4+; col.22, lines 5+; col.24, lines 47+). Carpentier further teaches means of determining whether the token is to be updated (col.12, lines 5+), and first 402 and second 460 tokens wherein the first token is different from the second one (see fig. # 7).

Re claims 2, 8, 14, and 21: Carpentier teaches a system and method, further comprising a token image server configured to store a plurality backup token images; wherein the retrieved backup token image is selected based on one or more predetermined criteria {i.e. a creation date of the meta data 302} (col.10, lines 49+).

Re claims 4, 10, 15, and 22 Carpentier discloses a system and method, wherein upon updating the current token image with the backup token image on the token, the update indicator

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in the portable token is set to ensure that no further update is automatically performed (col.10, lines 62+; col.12, lines 15+).

Re claims 11, 17, and 24: Carpentier teaches a system and method, wherein the portable token is a smart card (col.25, lines 12+).

Re claims 12 and 18-19: Carpentier discloses a system and method, wherein the token acceptance device is a smart card terminal {herein may be a personal digital assistant or mobile telephone} (col.25, lines 23-35).

Re claim 27: Carpentier teaches a system and method, wherein the backup token image comprises transaction information for a financial account (col.24, lines 52+).

Re claims 28-30: Carpentier discloses a system and method, wherein the current token image includes loyalty {herein broadly interpreted as the escrow software management program} program information (col.22, lines 55+).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Naim (U.S. 6,779,115) teaches portable device using a smart card to receive and decrypt digital data.

Tippler (U.S. 6,792,536) discloses smart card system and methods for proving dates in digital files.

Tarnovsky et al. (U.S. 6,880,752) teaches system and testing, verifying legitimacy of smart card in-situ and for storing data therein.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
March 5, 2006



THIEN M. LE
PRIMARY EXAMINER